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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,348	04/19/2001	Randall W. Ojanen	K-1786	2490

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Kennametal Inc.
P.O. Box 231
Latrobe, PA 15650

EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,348

Applicant(s)

OJANEN, RANDALL W.

Examiner

Sunil Singh

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17,29,30,32-40 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-17,29,30,32-40 and 43-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 15-17, 29-30, 32-40, 43-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant in the specification pages 10-11 explicitly states that the prior art in particular Emmerich '783 and Engle et al. '309 both teach protruding surfaces that are spring loaded so as to expand into the notch of a bore. Page 11 goes on to state that debris and dirt interferes with the inward radial play of the radial protruding surfaces making the tools very difficult and sometimes impossible to remove. Applicant then states that his protruding dimples are designed to require **no radial play**. It is the examiner's position that such a statement of the protruding dimples not requiring radial play is incorrect. In order for the sleeve (40) with dimples (46) to be inserted into bore 20 and then have the dimples snap into notch 38 there **must be some radial play**. Such radial play might not be to the extent of the prior art; nevertheless there must be some radial play; otherwise, the sleeve would be an interference fit with the bore and this is clearly not the case because the sleeve has slit (42). For example look at Figure 12, in order for dimple (46) to snap into

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notch (38) it would have to pass through a narrower inner sleeve diameter prior to getting to the notch therefore there must be some degree of radial play. Based on these discrepancies, one skilled in the art cannot make and/or use the invention as claimed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 15-17, 29-30, 32-40, 43-47 rejected under 35 U.S.C. 102(e) as being anticipated by Sollami (US 6397652).

Sollami discloses a cutting tool assembly, said assembly comprising:

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a cutting tool (10") a retainer sleeve (38") carried by the cutting tool, and including at least one radially outward protruding surface (31); wherein said retainer has a cylindrical circumference and a thickness dimension, the amount of radial projection of said protruding surface beyond the cylindrical surface of the retainer is between about 15 percent and about 30 percent of the thickness dimension of said retainer (see Fig. 15).

Response to Arguments

5. Applicant's arguments filed 11/12/2004 have been fully considered but they are not persuasive. Applicant's argument on page 8 of response contradicts itself. Applicant states that it is apparent that "less radial inward play" of the dimple (46) is necessary to remove the tool using the retainer of Fig. 12 than with the tools shown in Engle et al. or Emmerich. Applicant then goes on to say that "radial play is not a requirement" for removal of the tool. These statements clearly contradict themselves. It is the examiner's position that such a statement of the protruding dimples not requiring radial play is incorrect. In order for the sleeve (40) with dimples (46) to be inserted into bore 20 and then have the dimples snap into notch 38 there **must be some radial play**. **Such radial play might not be to the extent of the prior art; nevertheless there must be some radial play; otherwise, the sleeve would be an interference fit with the bore and this is clearly not the case because the sleeve has slit (42). For example look at Figure 12, in order for dimple (46) to snap into notch (38) it would have to pass through a narrower inner sleeve diameter prior to getting to the notch therefore there must be some degree of radial play.**

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Applicant's arguments with respect to claims 15, 29, 39, 40,43, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



SS



1/25/05